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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,599	10/29/2003	Gonzalo E. Labarca	CE11909JME	6879

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,599

Applicant(s)

LABARCA ET AL.

Examiner

Justin M. Larson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 8-11, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-11, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (US 2005/0115999 A1). Johnson discloses an electronic device carrying system, comprising: a belt clip member connected to a belt clip (350), the belt clip member having a central opening having at least one radiating channel (Figure 1J); a swivel base member attached to an electronic device carrying case, the base member having a central opening having at least one radiating channel (Figures 7A-7B); and a two-ended swivel member (460, Figures 7A-7B) coupled between the belt clip member and the swivel member, wherein the belt clip member and the swivel base members each include a cavity, and the first end of the two-ended swivel member is located within the belt clip component's cavity and the second end of the two-ended swivel member is located within the swivel base component's cavity such that the two-ended swivel member can be placed in a first position wherein its first and second ends can rotate within their cavities corresponding cavities and in a second position in which the two-ended swivel member is locked in place using the at least one radiating channels

found in the belt clip member and the swivel base member. Regarding the swivel member being "locked" in the radiating channel, Examiner notes that in Applicant's "locked" position, the swivel member merely lies within one of the radiating channels and can easily be rotated 180° back out of the channel along the same line of motion with which it was placed into the channel to a first position in which it is free to rotate about its end. The swivel member of Johnson can also lie within one of the radiating channels (Figure 7A) and can easily be rotated 180° back out of the channel along the same line of motion with which it was placed into the channel to a first position (Figure 6B) in which it is free to rotate about its end, and is therefore considered "locked" within the channel.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Williams, Jr. (US 6,793,108).

Regarding claim 2, Johnson discloses the claimed invention including a two-ended swivel member, one end being spherical, but fails to disclose the other end being spherical as well. Johnson's swivel member (460, Figure 6A) is by design intended to rotate only 180 degrees along a single axis ([0248]), however, Johnson discloses that in

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another embodiment, although not shown, the pin may be designed so as to allow a full 360 degree rotation.

Now, Williams, Jr. discloses a pivoting assembly where a swivel member (312) connects two base members (350 & 130) and teaches that forming both ends of the swivel member with a spherical shape and mounting them in spherical cavities allows for a 360 degree rotation of the swivel member with respect to each base member (Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a spherical end on the second end of the swivel member of Johnson, in addition to the first, and to mount that spherical end in a spherical cavity, as taught by Williams, Jr., in order to allow the swivel member to rotate 360 degrees with respect to each the swivel base member, providing a user with a greater degree of freedom when using the swivel clip.

Regarding claim 3, Johnson in view of Williams, Jr. discloses the claimed invention except for the first spherical end of the swivel member being smaller than the second spherical end. It would have been an obvious matter of design choice to make the first spherical end smaller than the second spherical end since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Regarding claim 12, the swivel member of the modified Johnson device comprises a two-ended swivel member that includes an extension that can be locked into one of the plurality of radiating channels.

5. Claims 8, 10, 11, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Williams, Jr. as applied in paragraph #4 above, and further in view of Ting (6,502,794).

Regarding claim 8, the Johnson device has components that are made of either plastic or metal ([0276], Johnson). It would have been obvious to one having ordinary skill in the art to manufacture each of the swivel member, belt clip member, and swivel base member out of plastic, as plastic is a cheap material that is also resilient and easy to manufacture, effectively satisfying the limitations of the claim.

Regarding claim 10, Johnson in view of Williams, Jr. as applied in paragraph #4 above discloses the claimed invention except for the belt clip member and swivel base member each having a plurality of radiating channels oriented 90° from each other.

Regarding these channels on the belt clip member, Ting teaches that the spherical end (1321) of a swivel member may be rotatably held in place using a spherical cavity (211) having radiating channels (see esp. Figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Johnson in view of Williams, Jr. as applied in paragraph #4 above by using a spherical cavity with radiating channels, as taught by Ting, in place of the groove and release pin of Johnson, in order to provide an art-equivalent means for rotatably and removeably securing the spherical end of a swivel member to a corresponding support structure.

Regarding these channels on the swivel base member, the Johnson device after being modified with respect to Ting now includes a belt clip member that includes a

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plurality of channels radiating 90 degrees from one another, allowing the neck of the swivel member to be held in four positions. It would have been obvious to one having ordinary skill in the art to also provide two additional channels on the swivel base member radiating 90 degrees from the two already located thereon, in order to increase the number of positions the neck of the swivel member could be held on the swivel base member.

Regarding claim 11, the claim combines limitations of claims 1, 2, and 10, which have already been shown to be unpatentable over the modified Johnson device.

Regarding the swivel member being locked into a channel on each of the belt clip member and the swivel base member, Regarding the swivel member being "locked" in the radiating channel, Examiner notes that in Applicant's "locked" position, the swivel member merely lies within one of the radiating channels and can easily be rotated 180° back out of the channel along the same line of motion with which it was placed into the channel to a first position in which it is free to rotate about its end. The swivel member of the modified Johnson device can also lie within one of the radiating channels on either of the belt clip member and swivel base member and can easily be rotated 180° back out of these channels along the same line of motion with which it was placed into the channels to a first position in which it is free to rotate about its end, and is therefore considered "locked" within the channels.

Regarding claim 14, the modified Johnson device includes an electronic device carrying case attached to the second member, effectively satisfying the limitations of the claim.

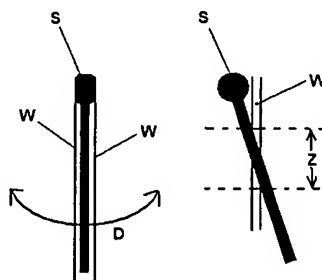
Regarding claim 15, the channels of the modified Johnson device are oriented 90 degrees from each other, effectively satisfying the limitations of the claim.

Response to Arguments

6. Applicant's arguments filed 6/6/06 have been fully considered but they are not persuasive.

Applicant has asserted that the phone attached to the clip of Johnson will assume only one position where the phone is permitted to freely rotate or otherwise be moved with little or no restriction, and is therefore never "locked" in place. Examiner notes that in Applicant's "locked" position, the swivel member merely lies within one of the radiating channels and can easily be rotated 180° back out of the channel along the same line of motion with which it was placed into the channel to a first position in which it is free to rotate about its end. The swivel member of Johnson can also lie within one of the radiating channels (Figure 7A) and can easily be rotated 180° back out of the channel along the same line of motion with which it was placed into the channel to a first position (Figure 6B) in which it is free to rotate about its end, and is therefore considered "locked" within the channel.

Examiner presents the following figure and explanation to illustrate a different position regarding the swivel member of Johnson being "locked" within the channel:



Looking at the figures above, the swivel member (S) is shown between the walls (W) of the radiating channel of the belt clip member. The left figure is a top view of the swivel member in the channel and the right figure is a side view of the swivel member in the channel. Note that Johnson discloses the swivel member being capable of 360° rotation within the channel ([0245], Figure 6C). When in the position shown, however, the swivel member is angled such that if a user attempts to rotate the swivel member in a 360° motion (D), the swivel member is blocked by a section (Z) of the channel wall. In this position, the swivel member is locked from the 360° rotation.

In response to applicant's argument that there is no suggestion to combine the Johnson and Ting references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner relied on the knowledge generally available to one of ordinary skill in the art. One of ordinary skill, after studying Johnson and Ting, would recognize that both inventions involve a swivel member held in a channel to lock the swivel member in place and would recognize that the four channels of Ting provide a greater degree of functionality or freedom of movement when compared to the channels of Johnson.

Applicant has asserted that Johnson teaches against the combination with the rear part of Ting because Johnson aims to minimize the outward profile of the phone

when attached to the clip by allowing the phone to hang at least partially below the clip. Examiner fails to see how the rear part of Ting in anyway goes against the goal of Johnson. When the swivel member of Ting is locked into one of the radiating channels, the swivel member and whatever object is attached to the swivel member hang at least partially below the base member having the radiating channels. When implemented on the clip of Johnson, the base member of Ting would certainly still allow the swivel member and phone to hang at least partially below the clip/base member, thereby minimizing the outward profile of the phone when attached to the clip.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML
8/17/06


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